



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, DC 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/238,405	05/05/94	CAPON	D CELL5.3

18M1/0516

DEAN H. NAKAMURA  
SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 PENNSYLVANIA AVE., N.W.  
SUITE 800  
WASHINGTON DC 20037-3202

EXAMINER

ALLEN, M

ART UNIT

PAPER NUMBER

1818

DATE MAILED:

05/16/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/238,405

Applicant(s)

Capon et al.

Examiner

Marianne P. Allen

Group Art Unit

1818



☒ Responsive to communication(s) filed on Dec 24, 1996

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 57 and 59-69 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 57 and 59-69 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this applicati

Claims 58 and 38-54 have been cancelled. Claims 57 and 59-69 are under consideration by the Examiner.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's arguments filed 24 December 1996 have been fully considered but they are not deemed to be fully persuasive.

The oath or declaration remains defective because non-initialed alterations have been made to the oath or declaration (see 37 C.F.R. §§ 1.52(c) and 1.57). It is noted that applicant's response indicates that a substitute declaration will be submitted.

The rejection of claims 60-61 are rejected under 35 U.S.C. § 112, first paragraph, is withdrawn as applicant has pointed to basis in the specification.

The rejection of claim 61 under 35 U.S.C. § 112, fourth paragraph, is withdrawn due to amendment to the claims.

The rejection of claims 57-69 under 35 U.S.C. § 112, first paragraph, is withdrawn due to amendments to the claims.

The double patenting rejections are maintained for reasons of record. When the only issue remaining is the provisional double patenting rejections, these will be withdrawn in accordance with the MPEP. This assumes that none of the other applications have been allowed or issued in the interim.

5           The unexecuted terminal disclaimer for 07/988,194 (U.S. Patent No. 5,359,046) is noted. Applicant is reminded that the executed declaration should be dated and specify the titles of those signing. The executed declaration has not been received.

10           The disclosure is objected to because of the following informalities: Claim 57 contains a typographical error. It appears that "signalling is said host cell" should read --signalling in said host cell.-- This appears to be an inadvertent error in retyping the claim in the most recent amendment. It also appears that line 14 of this claim should recite --extracellular binding domain-- rather than "extracellular domain."

15           Appropriate correction is required.

          Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

20           Claim 59 depends upon cancelled claim 58. Claim 59 also lacks antecedent basis in claim 57 for FcεR1. Claim 57 recites "Fc receptor."

It is believed that all pertinent arguments have been addressed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen, whose telephone number is (703) 308-0666. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, Ph.D., can be reached on (703) 308-4310. The most convenient FAX telephone number for this examiner is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Marianne P. Allen*  
MARIANNE P. ALLEN  
PRIMARY EXAMINER  
GROUP 1800